

AGILENT TECHNOLOGIES
Legal Department, 51U-PD
Intellectual Property Administration
P. O. Box 58043
Santa Clara, California 95052-8043

EP 1635
PATENT APPLICATION

ATTORNEY DOCKET NO. 10990393-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Jeffrey R. Sampson

Serial No.: 09/358141

Examiner: M. Schmidt

Filing Date: Jul 20, 1999

Group Art Unit: 1635

Title: Method Of Producing Nucleic Acid Molecules With Reduced Secondary Structure

ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

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MAR 07 2001

TECH CENTER 1600/25...

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- () Response/Amendment () Petition to extend time to respond
() New fee as calculated below () Supplemental Declaration
() No additional fee (Address envelope to "Box Non-Fee Amendments")
(X) Other: Response to Restriction Requirement (fee \$)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X \$18	\$ 0
INDEP. CLAIMS		MINUS		= 0	X \$80	\$ 0
[] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$270	\$ 0
EXTENSION FEE	1ST MONTH \$110.00	2ND MONTH \$390.00	3RD MONTH \$890.00	4TH MONTH \$1390.00		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 50-1078. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 50-1078 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 50-1078 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this sheet is enclosed.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Date of Deposit: Feb. 26, 2001

Typed Name: Leonor S. Tuck

Signature: Leonor S. Tuck

Respectfully submitted,

Jeffrey R. Sampson

By Michael J. Beck

Michael J. Beck

Attorney/Agent for Applicant(s)
Reg. No. 40,907

Date: Feb. 26, 2001

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D. C. 20231 on February 26, 2001.

By:

Leonor S. Tuck
Leonor S. Tuck

Date: February 26, 2001



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Jeffrey R. Sampson

Group Art Unit: 1635

Serial No.: 09/358,141

Examiner:

#11 / R.T. 3/7
ELECT.

Title: "Method of Producing Nucleic Acid Molecules with Reduced Secondary Structure"

Filed on: July 20, 1999

Attorney Docket No.: 10990393-1

Assistant Commissioner for Patents
Washington, D. C. 20231

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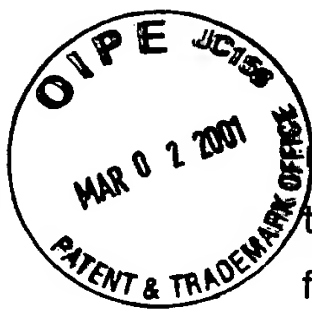
RESTRICTION REQUIREMENT

Dear sir:

In response to the Restriction Requirement mailed January 30, 2001, Applicants hereby elect Group IA, with traverse, and hold the remaining claims in reserve for later prosecution.

Applicants traverse the restriction requirement with regard to the requirement that Group I be subdivided into Groups IA-IE. The Examiner is referred to MPEP 803.02 relating to Markush claims, which states "If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the claims on the merits, even though they are directed to independent and distinct inventions."

Under Rule 1.141, Applicants may be allowed a "reasonable number of species." Applicants submit that five implementations, or species, in dependent claim 9 of the independent generic claim 1 is not such an unreasonable number or pose a serious burden to examine. Applicants have



met the requirements of Rule 1.141(a), and Applicants therefore request that the restriction requirement be reconsidered, and that Applicant be allowed to fully prosecute all of the Group I claims in this application.

The Examiner states that the enumerated species "each function by different mechanisms known in the art and thus would function differently in their capacity to make unstructured nucleic acids as claimed". In reply, Applicants wish to point out that the smallest intricacies of molecular mechanisms by which the enumerated species accomplish the polymerization of the precursors is NOT part of the claimed subject matter (although the fact that they are characterized by their ability to polymerize the precursors IS a defining aspect of the claims). Nor are the molecular-level intricacies of mechanism of the enumerated species of any practical consequence to the subject matter claimed (applicants are not claiming a particular molecular mechanism by which precursors may be polymerized). Pointing out that species are different from each other is insufficient, by itself, to build a case for requiring restriction. After all, species, by definition, are different from each other. More is needed to support a restriction requirement.

If the Examiner for the case would like to discuss the restriction requirement or any upcoming action on the case, the Examiner is invited to call the below-signed attorney.

Respectfully submitted,

By:

Michael J. Beck
Reg. No.: 40,907

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Date: February 26, 2001
Phone No.: (650) 485-3864